

### **REMARKS**

This Response is being filed in response to the Office Action dated August 18, 2003. Claims 1-9, 28-29, and 32-34 are currently pending in the application. Of these, claims 1, 28-29 and 32-34 are independent. Claims 1-9, 28-29, and 32-34 stand rejected in the outstanding Office Action. No amendments have been made herein and therefore new matter has been added. Favorable reconsideration of the application is respectfully requested in light of the following remarks.

#### **Inclusion of Group 1e, claims 28-29 and Group 1h, claims 32-34**

Applicants note with appreciation the inclusion of Group 1e, claims 28-29 and Group 1h, 32-34, for consideration in the present application.

#### **Rejection of Claims Under 35 U.S.C. §103(a)**

In the August 18, 2003 Office Action, the Examiner rejected claims 1-2, 4-9, 28-29 and 32-34 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,729,323 to Arden et al. (Arden) in view of U.S. Application Serial No. 2003/0137772 to Challener (Challener). Applicants respectfully submit that Arden in view of Challener fails to teach, suggest or render obvious each of the limitations of independent claims 1, 28-29 and 32-34.

Arden relates to sunglass lenses having a multilayer coating with improved transmittance and antireflection characteristics. The lens according to Arden comprises a multilayer coating on the concave side of the lens in order to reduce reflectance. The Arden coating is on the side of the lens because Arden is directed to minimizing the glare resulting from reflection of incident light at the concave surface. As described in Arden, when the concave surface of the lens is not coated, a portion of incident light at the concave lens surface would be reflected from the surface toward the wearer's eyes (Column 2, lines 64-65). Additionally,

Arden describes how a portion of the non-reflected light passing through an uncoated lens would be reflected from the convex surface of the lens toward the wearer's eyes (Column 2, line 65 to Column 3, line 4). In contrast to Arden, the present invention is directed toward a sunglass lens having a dual chromatic effect by utilizing at least one layer deposited in a gradient manner. Moreover, claims 1 and 29 specify that the coating layers are on the "outer surface" (which is the convex side of the lens) and claims 32-33 specify that the reflection is "observed from the side of the lens opposed to the eyes of the wearer" which again is the convex side of the lens. The objective of Arden is fundamentally different from, and teaches away from, the objective of the present application. Arden also fails to teach or suggest a gradient layer as required by each of the independent claims.

The lens according to Arden comprises a substrate in the form of a lens, a first layer comprising  $\text{TiO}_x$  wherein  $x$  is about 0.2 to 1.5 (Column 1, line 67 to Column 2, line 6), a second layer, uniformly covering the first layer, having a high refractive index and a third layer uniformly covering the second layer, having a low refractive index (Column 2, lines 40-46). Each of the three layers of Arden are deposited in a uniform thickness as seen in FIG. 1. Arden does not teach or suggest a dielectric layer gradiently covering only a part of the lens or the adjacent outer layer, as claimed in the application. The deficiencies of Arden are not remedied by Challenger.

The second reference that the Examiner relies upon for rejecting claims 1-2, 4-9, 28-29 and 32-34, Challenger, is entitled "Surface Plasmon Lens for Heat Assisted Magnetic Recording". Challenger is not within the same field as the present invention and does not pertain to the same problem as the present invention and therefore is not analogous art. The Federal Circuit has stated, "[t]wo criteria have evolved for determining whether prior art is analogous: (1) whether the art is from the same field of endeavor, regardless of the problem addressed, and

(2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved.” In re Clay, 966 F.2d 656, 658-59 (Fed. Cir. 1992) (citing In re Deminski, 796 F.2d 436, 442 (Fed. Cir. 1986)).

Challener is directed to an apparatus for focusing plasmon waves to a spot, which is fundamentally different and unrelated to lenses having chromatic effects. Whereas Challener is directed toward magnetic recording, the present application is directed toward lenses for use in sunglasses. Applicants respectfully maintain that Challener is not from “the same field of endeavor”, and is also not “reasonably pertinent” to the problem with which Applicants are involved. Accordingly Applicants respectfully maintain that Challener is not analogous art and the rejections based on Challener are inappropriate.

Additionally, because Challener is not within a related field with the application of Arden, Applicants respectfully maintain that it would not have been obvious to a person of ordinary skill in the art to combine the teachings of Challener with Arden. Furthermore, there is no motivation in either Arden or Challener to include a gradient layer in the coating of Arden.

Furthermore, and more importantly, Applicants respectfully maintain that Challener fails to teach or suggest a dielectric layer of gradient thickness partially covering a lens or a layer covering the lens as required by the claims of the present application. In the Office Action, the Examiner stated that Challener describes a third dielectric layer gradiently covering only a portion of the second dielectric layer. However, the third layer of Challener is “a cone-like cladding having an aperture” (Paragraph 51), which, as illustrated in Figure 9, has a uniform thickness, and not a gradient thickness as required by the claims of the present application. Additionally, although cladding 99 has an aperture, it nonetheless completely covers adjacent layer 86, in contrast to the claims of the present application, which require the gradient layer to

partially cover the layer or substrate that it is deposited on. Challener does not teach or suggest a gradient thickness of the third layer or of any dielectric layer. Accordingly, Applicants respectfully maintain that Challener does not remedy the deficiencies of Arden, and therefore, even if Arden is combined with Challener, the resultant combination does not teach or suggest each of the limitations of claims 1-2, 4-9, 28-29 and 34. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 1-2, 4-9, 28-29 and 34 under 35 U.S.C. §103.

Applicants also respectfully submit that Arden in view of Challener fails to render obvious claims 32 and 33, which claim a “lens comprising at least two zones with differently colored reflection” “when observed from the side of the lens opposed to the eyes of the wearer”. Arden is directed toward coating the lens on the concave surface, which is the side of the wearer, unlike claims 32 and 33, which claim the different colored reflection when observed from the side opposed to the side of the wearer. For the same reasons as the foregoing statements above, and further in light of the fact that claims 32 and 33 specify the side of the lens “opposed to the eyes of the wearer”, Applicants respectfully maintain that it would not have been obvious to modify Arden in view of Challener to obtain the lens of claims 32 and 33. Accordingly, Applicants respectfully maintain that Arden in view of Challener fails to render claims 32 and 33 obvious and respectfully request that the Examiner reconsider and withdraw the rejection of claims 32 and 33 under 35 U.S.C. §103.

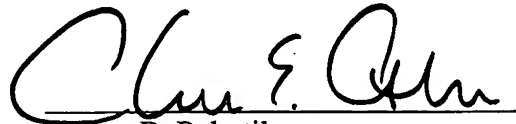
The Examiner rejected claim 3 under 35 U.S.C. 103(a) as being unpatentable over Arden in view of Challener and further in view of U.S. Patent No. 5,190,896 to Pucilowski et al. (Pucilowski). Applicants respectfully maintain that Pucilowski fails to resolve the shortcomings of Arden and Challener, and accordingly, Arden in view of Challener and Pucilowski fails to render claim 3 obvious.

Application No. 10/043,504  
Response dated November 13, 2003  
Reply to Office Action of August 18, 2003

No fee is deemed necessary in connection with the filing of this Response.

However, if any fee is required, the Examiner is hereby authorized to charge the amount of such fee to Deposit Account No. 19-4709.

Respectfully submitted,

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Steven B. Pokotilow  
Registration No. 26,405  
Attorney for Applicants  
STROOCK & STROOCK & LAVAN, LLP  
180 Maiden Lane  
New York, New York 10038-4982  
(212) 806-5400